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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/785,881	02/16/2001	Marinus Petrus de Baar	4760US	4204

7590

03/26/2004

TRASK, BRITT & ROSSA  
P.O. Box 2550  
Salt Lake City, UT 84110

EXAMINER
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WHISENANT, ETHAN C

ART UNIT	PAPER NUMBER
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1634

DATE MAILED: 03/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Supplemental  
Notice of Allowability**

Application No.

09/785,881

Examiner

Ethan Whisenant, Ph.D.

Applicant(s)

DE BAAR ET AL.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☐ This communication is responsive to \_\_\_\_\_.
2. ☒ The allowed claim(s) is/are 1-8, 16-18 and 21-25.
3. ☐ The drawings filed on \_\_\_\_\_ are accepted by the Examiner.
4. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) ☒ All    b) ☐ Some\*    c) ☒ None    of the:
    1. ☒ Certified copies of the priority documents have been received.
    2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\* Certified copies not received: \_\_\_\_\_.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.  
**THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
  6. ☒ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
    - (a) ☒ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
      - 1) ☐ hereto or 2) ☒ to Paper No./Mail Date 03/08/04.
    - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date \_\_\_\_\_.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

**Attachment(s)**

- |   |   |
|---|---|
| 1. <input type="checkbox"/> Notice of References Cited (PTO-892)  | 5. <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)           |
| 2. <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                | 6. <input type="checkbox"/> Interview Summary (PTO-413),<br>Paper No./Mail Date _____ |
| 3. <input type="checkbox"/> Information Disclosure Statements (PTO-1449 or PTO/SB/08),<br>Paper No./Mail Date _____ | 7. <input type="checkbox"/> Examiner's Amendment/Comment                              |
| 4. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit<br>of Biological Material          | 8. <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance  |
|   | 9. <input type="checkbox"/> Other _____   |

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## **SUPPLEMENTAL NOTICE OF ALLOWABILITY**

**1.** On 26 SEP 03 the applicant was mailed a Notice of Allowability in this application (09/785,881) indicating that Claims 1-9, 16-18 and 21-25 were allowable. Now, following a standard review it has been noted that no Primary Examiner's stamp or signature appeared on the Notice of Allowability. Upon further review, this examiner finds the claims to be allowable and hereby reiterates the **indication of Allowability**. The examiner did carefully consider the prior art of record but for the reasons outlined below finds such new grounds of rejection to be improper. Please note that the three month SSP is restarted to correspond to the date of this letter.

### **REASON FOR ALLOWANCE**

**2.** The examiner carefully considered a rejection of **Claim(s) 1-2 and 16** under 35 U.S.C. 103(a) as obvious over Tyagi et al. (1998) in view of Guo et al. (1997) which appears to be the best prior art available. However, this rejection has been found to be deficient because, as noted by the applicant on p. 4 of the paper(s) filed 22 AUG 03, Tyagi et al. teaches away from the claimed invention. Based on teachings present in Tyagi et al. there would be no reason (i.e. no motivation) to apply the methodology of Guo et al. to Tyagi et al. in order to improve the specificity of the allele specific hybridization reactions disclosed in Tyagi et al. Please note that on page 307 wherein Tyagi et al. describe the "extraordinary specificity of molecular beacons."

### **CONCLUSION**

**3.** **Claim(s) 1-9, 16-18 and 21-25** is/are allowable for the reason(s) of record and have now been renumbered as Claims 1-17.

**4.** Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ethan Whisenant, Ph.D. whose telephone number is (571) 272-0754. The examiner can normally be reached Monday-Friday from 8:30AM -5:30PM EST or any time via voice mail. If repeated

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attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion, can be reached at (571) 272-0782.

The fax number for this Examiner is (571) 273-0754. Before faxing any papers please inform the examiner to avoid lost papers. Please note that the faxing of papers must conform with the Notice to Comply published in the Official Gazette, 1096 OG 30 (November 15, 1989).



**ETHAN WHISENANT**  
**PRIMARY EXAMINER**

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